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No. 00-127

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

SEMICONDUCTOR ENERGY LABORATORY CO., LTD.,
Petitioner,

v.

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
and SAMSUNG SEMICONDUCTOR, INC.,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

SUPPLEMENTAL BRIEF FOR PETITIONER

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SUPPLEMENTAL BRIEF FOR PETITIONER

SEL filed its petition for a writ of certiorari on July 21, 2000. In opposing Samsung's cross-petition for certiorari, No. 00-138, we argued that the Solicitor General's position in *Buckman Co. v. Plaintiffs' Legal Committee*, No. 98-1768, warranted reversal of the Federal Circuit's decision against SEL also. SEL assumes that this Court decided to hold consideration of its petition pending the outcome of *Buckman*. On February 21, 2001, this Court decided *Buckman* in the manner favored by the Solicitor General. Petitioner believes that the reasoning and outcome of *Buckman* should result in the granting of its certiorari petition, the vacating of the Federal Circuit's decision, and either a full hearing in this Court or a remand to the Federal Circuit for reconsideration in light of *Buckman*.[1]

In particular, the central theme of SEL's petition was that it complied with the disclosure rules of the PTO in prosecuting its '636 patent. In accordance with the PTO rules that dictated its conduct, SEL provided the prior art patent (in Japanese), a pre-existing partial translation of it, and a concise statement that accurately identified that a feature in the prior art patent corresponded with a '636 claim limitation. SEL had no further obligation under the PTO rules governing its conduct, yet was found guilty of committing a fraud by omission on the PTO in the prosecution of its patent. The Federal Circuit was of the view that it could use the inequitable conduct doctrine to find common law fraud by omission even when PTO rules and its operating manual imposed lesser disclosure obligations, which admittedly had been satisfied by SEL.

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[1] This Court might also consider indicating that the decision below should be reconsidered in light of the Federal Circuit's later, apparently contrary, panel ruling in *Fiskars, Inc. v. Hunt Mfg. Co.*, 221 F.3d 1318 (Fed.Cir. 2000) (discussed in petitioner's reply brief).

In *Buckman*, this Court made two statements that directly support SEL's petition:

> (1) Here, the petitioner's dealings with the FDA were prompted by the MDA, and the very subject matter of petitioner's statements were dictated by that statute's provisions. Op. at 5.
>
> (2) Conversely, fraud-on-the-FDA claims would cause applicants to fear that their disclosures to the FDA, although deemed appropriate by the Agency, will later be judged insufficient in state court. Op. at 9.

We believe it is clear that the Solicitor General's position in regard to the proper result in *Buckman* was in no way limited to preemption cases. In its September 2000 amicus brief in *Raquel v. Education Management Corp.*, No. 99-1489, the Solicitor General asked for the reversal of a Third Circuit ruling which imposed on a petitioner for a U.S. copyright disclosure duties greater than those set out in the agency's manual of procedure. SEL is in exactly the same position.

For the foregoing reasons SEL requests that its petition for a writ of certiorari be granted.

Respectfully submitted,

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